

No. 15,104.

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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ORIENTAL FOODS, INC., a corporation,

*Appellant,*

*vs.*

CHUN KING SALES, INC. and JENO F. PAULUCCI,

*Appellees.*

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CHUN KING SALES, INC. and JENO F. PAULUCCI,

*Appellants,*

*vs.*

ORIENTAL FOODS, INC., a corporation,

*Appellee.*

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Reply Brief of Appellant Oriental Foods, Inc.

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**Reply Brief of Appellant Oriental Foods, Inc.**

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**Introduction.**

This is the reply of appellant-defendant Oriental Foods, Inc., to the "Answering Brief of Plaintiffs-Appellees-Appellants," sometimes referred to hereinafter for convenience as "Appellees' Brief."

Appellees' Brief is significant in the following general respects:

(a) Appellees' Brief ignores and does not attempt to answer many of the principal contentions of our Opening Brief; and

(b) Appellees' Brief consists largely of statements unsupported by the record.

Most of the major contentions of Appellees' Brief have been answered in advance by Appellant's Opening Brief. Some require further comment herein. All emphasis is ours unless otherwise noted.

### **There Was No Need in the Art.**

Appellees' Brief (pp. 2-3) argues that there was a need in the art for the method of claim 1 of the Paulucci patent in suit. There is no evidence in this action to support such a contention.

Defendant Oriental started hand taping cans together in June, 1949, continued until early in 1950 [R. 270-272, 468-469, 472-474], and sold thousands of cases of cans so taped during this period [R. 470, 475-482]. There is no evidence that any of such hand taping was unsatisfactory, and Oriental recommenced hand-taping in 1954 [R. 472, 492, 495], and does so in the same manner today [R. 469, 472]. Defendant purchased its Dellenbarger machine by an order dated May 3, 1954 [R. 100] but did not start using it until September, 1954 [R. 153]. Even after defendant got the Dellenbarger machine, it continued to hand-tape cans together.

Plaintiff Chun King started taping cans together in June, 1949, by a hand method which it asserts was not covered by the Paulucci patent in suit, and continued to do so until about the end of August, 1951, as we pointed out in our Opening Brief (pp. 6-8). During this period, plaintiff sold thousands of cases of cans so taped together, and its sales of the product increased substantially, there being a steady growth in sales [R. 419-421]. Plaintiff Paulucci testified that Chun King's fiscal year ends June 1, that in the year ending June 1, 1950, its

sales amounted to about \$1,250,000, and in the year ending June 1, 1951, its sales were \$3,500,000 [R. 189-190]. Thus, Chun King's sales increased very substantially each year that it taped cans before use of the alleged invention of the patent in suit. This, we suggest, clearly shows that the plaintiffs' old method was entirely satisfactory.

Plaintiffs called no disinterested witness to testify to any inadequacies in either its or Oriental's early hand-taped products, or to any need in the art.

### **The Method of the Paulucci Patent in Suit Did Not Fill Any Need.**

There is no evidence in this case that either plaintiffs, defendant, or anyone else ever commercially used the method defined by claim 1 and described in the specification of the Paulucci patent in suit.

"Step 2" of claim 1 requires that a *portion* of the tape be stretched before *any* is applied to the cans; and that said portion is applied while in such stretched condition (Our Op. Br., pp. 4-5, 29). Appellees' Brief (p. 18) asserts that this is an *essential step* of the patented method.

There is no contention by Chun King that it has ever used any method including such a step, and the evidence is that in the only method actually used by Chun King since August, 1951, no portion of the tape is stretched before the initial application to the cans; in the Chun King commercial method the loose end of tape is merely "tabbed" or pressed onto the cans before *any* tension is applied.

### The Operation of the Accused Machine.

Appellees' Brief (p. 5) admits that the defendant's witnesses Peterson and Johnson described the defendant's accused Dellenbarger machine. Appellees' Brief does not in any respect challenge or criticize their testimony, and apparently accepts it entirely. Plaintiffs called no witness to describe the construction or operation of the Dellenbarger machine. Consequently, there is no conflict in the evidence as to its construction and operation. The testimony of Peterson and Johnson clearly establishes that the operation of the Dellenbarger machine does not include the specific steps of the Paulucci patent in suit, as we pointed out in detail in our Opening Brief (pp. 15-19, 28-34).

Appellees' Brief (pp. 5-7) characterizes the roller *C* shown in Exhibit 21 as a "tensioning" roller, but this characterization has no support whatever in the evidence. In fact, the evidence is clearly to the contrary. Engineer Johnson clearly explained that the clutch roller *C* operates freely to allow the tape to be applied to the cans but has a one-way clutch mechanism to prevent the roller reversing its rotation, so as to prevent the tape from pulling out in the reverse direction [R. 322, 346-347]. The uncontroverted evidence is that in the operation of the Dellenbarger machine there is *no* tension on the tape until long after it has been initially applied to the cans, and until the initial "free loop" of tape has been taken up as shown in Exhibit X-3 [R. 678], as pointed out by engineer Johnson [R. 330, 332].

Appellees' Brief (p. 7) also asserts that in the Dellenbarger machine the "pre-stripping roller" *A* serves to greatly increase tension on the tape and that this is suf-



ficient to stretch the tape. There is absolutely no support for this contention in the evidence and, in fact, the evidence is to the contrary. The function of the “pre-stripping” roller *A* is merely to provide a loose “free loop” of tape to insure that there will be *no tension* on the tape when it is initially wiped onto the cans [R. 332]. Of course, during the latter part of the cycle of operation of defendant’s machine, as shown in Exhibits X-4 and X-5 [R. 678, 679], some tape is stripped from the roll of tape *T*, and this requires a slight pull, as anyone knows who has ever pulled “Scotch” brand sticky tape from a roll. However, such pull or tension is insufficient in defendant’s machine to *stretch* the tape [R. 345], as required by claim 1.

However, as above pointed out the “essential step” of the method of claim 1 is what is referred to both by appellant and appellees as step 2, which calls for:

“ . . . stretching a portion of a slightly resilient sticky tape and applying said portion of said tape over portions of the abutting beads and adjacent side walls of said cans *while the tape is in a stretched condition to secure said cans together.* . . .”

This step can only refer to the “portion” of tape which is *first* applied to the cans as set forth in the specification of the Paulucci patent (Our Op. Br., pp. 4 and 5 and 29). Since this “essential step” is entirely lacking in the alleged infringing operation of the Dellenbarger machine as pointed out in our Opening Brief, pages 16-17, appellees have elected to ignore this fact, even to the extent of *omitting the essential clause* emphasized above in their statement of this portion of claim 1 at the bottom of page 6 of their Brief, and have merely attempted to show that the tape is stretched somewhere or at some time

during the operation. The most they are able to show is that the tape is pulled enough to remove it from the supply roll. This slight tension would have to be used in *any* use of the tape, including the admittedly prior uses of both Chun King and Oriental. Accordingly, appellees have entirely failed to show that appellant's use of the Dellenbarger machine utilized the "essential step" of claim 1 of the Paulucci patent.

In attempting to lift the method of claim 1 of the Paulucci patent to valid patentable dignity appellees assert (pp. 3 and 4) as a "new, startling and highly unexpected result" that:

"In applying the tape over the irregular contour of the heads of the cans and onto the side walls thereof while in a stretched condition, the tape was *extended transversely of its length. . . .*"

and that:

"Such transverse extension of the tape and the force resulting therefrom is a completely unexpected and surprising result."

Appellees then rely upon this "phenomenon" to (a) establish infringement of the Dellenbarger machine (p. 7); (b) avoid anticipation by Chun King's own prior use (p. 14) and the prior use by Oriental (p. 15); (c) avoid anticipation by the Nifong patent (p. 18); and finally (d) in their concluding summary as establishing novelty and utility (p. 19).

If this "new, startling and highly unexpected result," *i. e.*, that by applying *lengthwise* tension to a length of "slightly resilient" tape is could be "*extended transversely of its length*" were in fact true, it would indeed be as above characterized since it would be directly contrary to

all previously established laws of physics. However, there is absolutely nothing in the record to sustain this alleged "discovery." It is not mentioned or even suggested in either the specification or any claim of the Paulucci patent. There is no testimony of any witness even suggesting such an amazing situation. Appellees' counsel did not realize its existence and in fact in his final argument [R. 507] went to considerable pains first to point out "that there is *no stretching* of the tape at its edges on the opposite sides of the beads, but the tape is actually stretched so that it is permanently deformed in its central portion"; and to emphasize as "a very important factor" and as "the factor of invention in this case" the application of "that quantum of tension to the tape as the cans are rolled, and in *a direction of following the tangent* at the point of application of the tape so that the tape in that center portion is stretched and permanently deformed. . . ." Appellees' counsel was clearly asserting that, due to the irregular cross-section of the beads the tape was being stretched *longitudinally* more in the center of the strip than at the edges thereof. He was not even suggesting *extension* of the tape *transverse* to its length which is now asserted as the amazing discovery which imparts invention to the claim here in issue. This "discovery" springs full blown for the first time in this record in Finding of Fact 7 [R. 83]. The accuracy of this Finding of Fact is an issue of this appeal and, because of appellees' extensive reliance upon it as above noted it becomes a very important issue.

Since as above pointed out there is no shred of evidence in the record to support this finding or even any assertion of the alleged "fact," it should be held to be in error as being clearly unsupported by the record.

*Appellees do not even attempt to explain how the “new, startling and highly unexpected” result is obtained, obviously because they cannot do so since it is non-existent.*

### Interpretation of the Paulucci Patent in Suit.

Appellees' Brief (pp. 9-12) argues that the doctrine of file-wrapper estoppel does not apply to this case, upon the fine-spun technicality that although Paulucci submitted claim 4 of his application to the Patent Office, had it rejected by the Patent Office, and concurred in accepting his patent without it, still he technically had no appeal from the rejection. Such reasoning should receive short shrift from a court of equity, we suggest.

The proceedings had in the Patent Office with respect to such proposed claim 4 clearly indicate the interpretation put upon claim 1 by both the Office and the applicant, and clearly define the metes and bounds of the patent grant. Appellees assert no logical reason why such proceedings should not create a file-wrapper estoppel, and cite no authority in support of their assertion. The case of *Musher Foundation, Inc. v. Alba Trading Co., Inc.*, 150 F. 2d 885, cited by appellees, has no application here, because in that case the applicant merely made a voluntary selection between *allowed* claims, the cancelled claims never having been rejected by the Patent Office.

Had Paulucci wished to press for the allowance of claim 4 of his application, he could have pursued either of two courses: (a) he could have petitioned the Commissioner of Patents for a review of the Examiner's rejection of claim 4; or (b) he could have filed a continuation application containing claim 4, and if claim 4 were rejected therein, he could have prosecuted appeals as far as the Supreme Court of the United States to review

such rejection. Paulucci followed neither of these courses. He merely accepted his patent without claim 4 therein.

By accepting his patent without his proposed claim 4 Paulucci *acquiesced* in the rejection of the claim by the Patent Office. Such acquiescence by a patent applicant in a rejection by the Patent Office is the basis of all file-wrapper estoppel.

For the reasons set forth in our Opening Brief (pp. 29-31), we suggest that the doctrine of file-wrapper estoppel limits the interpretation to be placed on claim 1 of the patent in suit so that it is not infringed by defendant Oriental. It should be noted, however, that it is not necessary to apply the file-wrapper estoppel doctrine to hold that defendant does not infringe, because merely by interpreting claim 1 at its face value defendant's Dellenbarger machine does not utilize the method of claim 1.

It is also to be noted that the statements by Paulucci's attorney to the Patent Office as to how infringement of claim 1 of the patent in suit can be avoided [R. 579, 582], may be used here to indicate the construction that should be given to claim 1. See *Warren Bros. Co. v. Thompson*, 293 Fed. 745, 747 (C. C. A. 9th, 1923); *Schneitzer v. Calif. Corrugated Culvert Co.*, 140 F. 2d 275 (C. C. A. 9th, 1944.)

### **The Johnson Patent No. 2,652,166.**

As pointed out in our Opening Brief (pp. 42-44), the evidence establishes that Johnson patent No. 2,652,166 shows a taping mechanism substantially the same as that embodied in defendant's accused Dellenbarger machine, which operates in substantially the same way to produce substantially the same result. If the operation of the Dellenbarger machine infringes the Paulucci patent in

suit, the Johnson patent anticipates it, because “that which infringes if later, anticipates if earlier.”

Appellees’ Brief (pp. 16-17) attempts to point out some structural differences between the mechanisms of the Johnson patent and the Dellenbarger machine. There is no evidence that any such possible differences produce any difference in the operations of the mechanisms. The identity of function of the two mechanisms was established by the technical witnesses Peterson and Johnson [R. 305-306, 333-334, 343] and there was no conflicting evidence.

There are two significant erroneous statements in Appellees’ Brief in this connection.

First, Appellees’ Brief (p. 17) asserts that there was no “pre-stripping roller” in the Johnson patent. This is clearly wrong, because the Johnson patent clearly describes a “pre-stripping roller” 122, similar to the pre-stripping roller in defendant’s machine [Johnson patent, R. 659, col. 6, lines 21-66].

Secondly, Appellees’ Brief (p. 17) asserts that the roller *C* of defendant’s machine [Ex. 21-C] is serrated longitudinally, whereas the corresponding roller 73 of the Johnson patent is not serrated. This is correct, but appellees’ statement that such serrations increase the tension on the tape is wholly unsupported by the record and is contrary to the uncontroverted evidence [R. 346-348, 351-352].

### **The Nifong Patent No. 2,120,504.**

Appellees’ Brief (p. 18) attempts to avoid the pertinency of the Nifong patent No. 2,120,504 [R. 608] on the ground that Nifong “does not put enough tension on the tape to stretch the same *prior to application* to



the cans.” Obviously, this is a direct admission by appellees that claim 1 of the Paulucci patent in suit is limited to a method in which tension is put on a portion (the loose end) of the tape before the tape is applied to the cans. If the Paulucci patent in suit is so limited, as we fully agree it is, the accused Dellenbarger machine does not infringe because it does not put any tension on the tape before initial application to the cans, as we pointed out in our Opening Brief (pp. 16-17, 29-32).

Appellees admit (by failing to deny) that in the operation of the mechanism of the Nifong patent tension is applied to the tape as it is wound on the cans and that it is sufficient to cause the tape to pass around the irregular contour of the bead 146 to smoothly engage the side walls of the can and top, as pointed out in our Opening Brief (pp. 20, 45-46). This is exactly what plaintiffs’ counsel asserted was the alleged invention of the Paulucci patent in suit [R. 111, 115].

### Conclusion.

We submit that Appellees’ Brief does not answer the principal contentions made by appellant Oriental Foods, Inc., on this appeal, and that the decision of the District Court on the patent issues should be reversed for the reasons stated in our Opening Brief.

Dated: February 23, 1957.

Respectfully submitted,

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